

Atty Dkt. No.: 10003516-1
USSN: 09/938,937

REMARKS

The Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Formal Matters

Claim 10 has been amended to specify that at least one region of the nucleic acids in the first plurality of nucleic acids is designed to be complementary to a nucleotide sequence of a second plurality of nucleic acids, in which the first plurality of nucleic acids is immobilized on a surface such that different sequences of the first plurality of nucleic acids are spatially addressed and can be differentiated by location, and where each first region of nucleic acids of the second plurality is designed to be complementary to a nucleotide sequence of nucleic acids of the first plurality. Support for this amendment can be found in the specification on page 7, lines 1-11 and page 22, lines 1-9 as exemplary locations. Because these amendments add no new matter and place the claims in condition for allowance, entry thereof by the Examiner is respectfully requested.

Claim Rejections – 35 USC § 112

Claims 10-14 were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicants respectfully disagree, and traverse the rejection.

With respect to enablement: "[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."¹

¹ *United States v. Teletronics, Inc.*, 8 USPQ 2d 1217, 1233 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989). See also *Genentech, Inc. v. Novo Nordisk*, 42 USPQ 2d 1001 (Fed. Cir. 1997), *cert. denied*, 522 U.S. 963 (1997); *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ 2d 1001 (Fed. Cir. 1991).

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The instant claims are now directed to, *inter alia*, a method of assaying target nucleic acid molecules including providing a first plurality of nucleic acids in which at least one region of the nucleic acids in the first plurality is designed to be complementary to a nucleotide sequence of a second plurality of nucleic acids, in which the first plurality of nucleic acids is immobilized on a surface such that different sequences of the first plurality of nucleic acids are spatially addressed and can be differentiated by location, and in which the nucleic acid at each location has a different nucleotide sequence than nucleic acids at other locations; and providing a second plurality of nucleic acids, in which the nucleotide sequence of each nucleic acid of the second plurality is known and includes a first region and a second region, in which each first region of each nucleic acid of the second plurality has a different nucleotide sequence from other first regions of other nucleic acids of the second plurality, in which each first region of nucleic acids of the second plurality is designed to be complementary to a nucleotide sequence of the first plurality of nucleic acids.

The Examiner, in the previous and current Office Actions, has sought to base the enablement rejection on the grounds that the claims assertedly do not provide for any means to correlate any one position or location of the surface with any specific nucleotide sequence.

Instant Claim 10 specifically recites that at least one region of the nucleic acids in the first plurality is designed to be complementary to a nucleotide sequence of the second plurality of nucleic acids and that different sequences of the first plurality of nucleic acids are spatially addressed and can be differentiated by location. As such, since the sequence of each of the second plurality is known, so must the region of the first plurality to which it is designed to be complementary.

Accordingly, it is plain to one of skill in the art upon reading the instant specification that any bound molecule may easily be differentiated by location, as is

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claimed, since the sequence and location of each of the first plurality of nucleic acids is known and any labeled or otherwise detectable molecules bound to it therefore also will be of known location and sequence.

With regard to the construction of such an array, the specification provides several methods well known to one of skill in the art, including solid phase synthesis or synthesis on control pore glass or other substrates followed by covalent attachment to the array, synthesis *in situ* directly on the array at a known position, etc. (please consult pages 32 through 36 of the specification, the section entitled "Synthesis of UNAs").

As such, the Applicants submit that the specification enables the ordinarily skilled artisan, using techniques well known in the art, to readily perform the method as claimed.

In view of the foregoing discussion it is believed that the rejection has been adequately addressed. Withdrawal of the rejection is respectfully requested.

Claims 10-14 are rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner states that Claim 10 is indefinite with respect to what constitutes the metes and bounds of a "universal array."

Without in any way agreeing with the position of the Office and solely in order to expedite prosecution of the application, the Applicants have amended Claim 10 to remove the assertedly indefinite language and, as such, respectfully request reconsideration and withdrawal of the rejection.

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CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 833-7770.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10003516-1.

Respectfully submitted,

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By: 

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